

Upon the election of Groups I, III, or IV, the Examiner further required restriction to a single sequence. Upon the election of Group II, the Examiner further required restriction to a particular pair of sequences to be examined as a combination as set forth in MPEP § 803.04.

Applicant respectfully traverses the restriction requirement and provisionally elects the subject matter of Group I, presented in claims 1-7, drawn to polynucleotides selected from the group consisting of SEQ ID NO: 1, for further prosecution. However, Applicant submits that the Patent Office has not proven that the search and examination of the entire application would impose an undue burden. Applicant submits that the complete examination would be handled most expeditiously by treating all of the pending claims as a single entity. As MPEP § 803 directs, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Applicant respectfully submits that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted.

Applicant submits that no serious burden is created for the Examiner by running a simultaneous computerized search of the nucleic acids of these Groups. Applicant strenuously objects to the restriction between Groups I and II both of which are classified in the same class and subclass. The single search may be run in conjunction with databases such as those available at [www-ncbi.nlm.nih](http://www-ncbi.nlm.nih). As such, restriction between at least Groups I and II is improper and should be withdrawn.

Moreover, a single search for a particular nucleotide sequence and its translation product, for example, would automatically yield results from Groups I-IV without any undue burden on the Examiner. Furthermore, the Examiner contends that “[e]ach of the products [of Groups I - III] can be shown to be distinct from the method of Group IV as the product is either not used in the method or it has additional uses.” Office Action of May 23, 2002 at page 2. In fact, the Examiner has presented no evidence why the transformed plants of Group III could not be used in the methods of Group IV.

The Examiner has imposed sequence election requirements applicable to the groups because “[n]ucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another.” Office Action of May 23, 2002 at page 1. However, this approach contravenes the USPTO policy as set forth in the Manual of Patent Examining Procedure stating that “to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided ... to permit a reasonable number of such nucleotide sequences to be claimed in a single application.” (MPEP, 8<sup>th</sup> ed., August 2001, Section 803.04). The MPEP further provides that “[i]t has been determined that normally ten sequences constitute a reasonable number for examination purposes.” (emphasis added) *Id.* While the Examiner requires that a single nucleotide sequence be selected for Groups I, III, or IV or a single pair for Group II, no reason has been provided for this deviation from articulated Patent Office policy. (Office Action dated May 23, 2002 at page 1-2; MPEP, 8<sup>th</sup> ed., August 2001, Section 803.04).

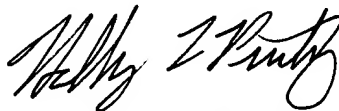
Based upon the foregoing, Applicant submits that the restriction requirement is improper and therefore must be withdrawn. However, in order to facilitate prosecution, Applicant has

provisionally elected, with traverse, the subject matter of Group I and specific nucleotide sequence set forth in SEQ ID NO: 1.

Should the Examiner have any questions regarding this application, the Examiner is invited to telephone the undersigned at the number provided.

Applicant does not believe that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in the documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account Number 13-4125, referencing docket number 16517.144/38-21(15677)B. Applicant likewise authorizes a charge to Deposit Account Number 13-4125 for any other fees related to the present application that are not otherwise provided for in the accompanying documents.

Respectfully submitted,



David R. Marsh (Reg. No. 41,408)  
Holly Logue Prutz (Reg. No. 47,755)

Date: July 23, 2002

ARNOLD & PORTER  
555 Twelfth Street, N.W.  
Washington, D.C. 20004-1206  
(202) 942-5000 telephone  
(202) 942-5999 facsimile